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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/984,979 12/04/97 BAER

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EXAMINER

MM91/1023

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PALO ALTO CA 94304-1018

PUNNOOSE, R

ART UNIT

PAPER NUMBER

2877  
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10/23/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/984,979

Applicant(s)

BAER ET AL.

Examiner

Roy M. Punnoose

Art Unit

2877

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-77 is/are pending in the application.
- 4a) Of the above claim(s) 45-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44, 48-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

Serial Number: 08/984,979

Filing Date: 12/04/97

Detailed Office Action

***Response to Arguments***

Applicant's arguments with respect to claims 1-44,49-77 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 49-50,52,63-64,70,77 are rejected under 35 U.S.C. 102(b) as being anticipated by Buck et al (Science, Vol 274, 8 Nov 1996).

Buck discloses a Laser Capture Microdissection (LCM hereinafter) system comprising: a transfer film carrier or a cap (fig 1A, transfer film carrier), a LCM film coupled to the carrier (fig 1A, transfer film), a plate (fig 1A, glass slide) having a top surface.

With respect to claim 50, the expanded transfer film would have been inherent because the transfer film need expands and projects itself away from the substrate in order to pick only a wanted tissue.

With respect to claim 52,70, Buck's transfer film contains an absorptive substance (page 2,

column 3, last paragraph and page 3, column 1, first paragraph).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-44,51,53-62,65-69,71-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buck et al (Science, Vol 274, 8 Nov 1996) in view of Chao et al (5,633,535) or Seffernick (5,621,619) or Nagahara et al (3,995,941).

Buck discloses a Laser Capture Microdissection (LCM hereinafter) system comprising: a transfer film carrier (fig 1A, transfer film carrier), a LCM film coupled to the carrier (fig 1A, transfer film), a plate (fig 1A, glass slide) having a top surface.

With respect to claims 1,15-16,30-31,44, Buck discloses the claimed invention except for the spacer or standoff to control the space. Chao (fig 1, 15 or fig 5, 42, column 2, lines 50+) or Seffernick (fig 1, 5 or column 4, lines 20-30) or Nagahara (column 4, lines 10-25) discloses a spacer or a standoff for controlling the space between two surfaces; specially Nagahara discloses an integrally formed spacer (column 4, lines 10-25). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine Buck with the spacer in the prior arts for controlling the space between two surfaces to save the cost as taught by Chao in column 2, lines 50-60.

With respect to claims 2,17, the expanded transfer film would have been inherent because the

transfer film need expands and projects itself away from the substrate in order to pick only a wanted tissue.

With respect to claims 3,5-9,18,20-24,38-39,43,51,53-57,71-76, The claimed limitations would have been a design choice, since the general conditions of the invention are described by the prior art, modifying the prior art with a scattering media or hot vacuum bake or transparent glue or a negative draft or diffuser involve only routine skill in the art.

With respect to claims 4,19,37, Buck's transfer film contains an absorptive substance (page 2, column 3, last paragraph and page 3, column 1, first paragraph).

With respect to claims 10-12,25-27,40-42,58-60, Buck discloses the claimed invention except for the transfer film thickness or length of the spacer. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the prior art system with different film thickness or different spacer length, since it would have been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

With respect to claims 13,28,61, a pedestal that protrudes and defines an acquisition zone is well known in the art, i.e. a cookie cutter. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the claimed pedestal with a transfer film to make the system more accurate.

With respect to claims 14,29,62, the claimed pedestal that runs at least three points of a perimeter would have been a design choice. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the shape or area of the pedestal to meet a design choice.

With respect to claims 32-34,65-67, Buck discloses the claimed invention except for the release layer. A release layer consisting of silicones and polytetrafluoroethylenes is well known in the art. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the Buck's system with a release layer to make the system easier to clean or easier to handle the tissue.

With respect to claim 35,68, Buck discloses a cap (fig 1 (A), transfer film carrier). However, Buck fails to disclose a Plano-concave void. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Buck's cap with a Plano-concave void to make the system more efficient.

With respect to claim 36,69, Buck discloses a transparent thermoplastic for the LCM (page 1, column 3, Fig 1. (A)).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Examiner Roy M. Punnoose** whose telephone number is **703-306-9145**. The examiner can normally be reached on 8:30 AM - 5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the applicant can reach his ***Supervisory Patent Examiner***, **Frank G. Font**, at (703) 308-4881.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a **general nature** or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-0530.

**Roy M. Punnoose**  
Patent Examiner  
Art Unit 2877  
October 16, 2001



  
\_\_\_\_\_  
**Mr. Frank G. Font**  
Supervisory Patent Examiner